UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,064	11/20/2003	Luca Ferri	FR920030006US1	8678

50170   7590   05/09/2008
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EXAMINER
TRAN, ELLEN C

ART UNIT	PAPER NUMBER
2134	

MAIL DATE	DELIVERY MODE
05/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>11 February 2008</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-8</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-8</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☒ Some * c)☐ None of:
    1.☒ Certified copies of the priority documents have been received.
    2.☒ Certified copies of the priority documents have been received in Application No. <u>10/718,064</u>.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to: amendment filed on 11 February 2008 with an original

application filed on 20 November 2003 with acknowledgement of the benefit of a foreign

application filed 10 March 2003.

2.   Claims 1-8 are pending; claims 1 and 8 are independent claims. Claims 9-19 have been

canceled amendment to the claims is accepted.

Response to Arguments

3.   Applicant's arguments filed 11 February 2008 have been fully considered however they

are moot due to new grounds of rejection.

Specification

4.   The disclosure is objected to because of the following informalities: On page 6, the

paragraph beginning with "A Certification Authority (CA) garantees", the word "guarantees" is

misspelled "garantees". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and
> distinctly claiming the subject matter which the applicant regards as his invention.

6.   Claims 1-8, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. Both independent claims contain the term "entity" however it is not clear if the

term 'entity' applies to the client or product. Appropriate correction is required. The dependent

claims 2-7 are rejected based on there dependency to the independent claim 1.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

> (e) the invention was described in (1) an application for patent, published under section
> 122(b), by another filed in the United States before the invention by the applicant for
> patent or (2) a patent granted on an application for patent by another filed in the United
> States before the invention by the applicant for patent, except that an international
> application filed under the treaty defined in section 351(a) shall have the effects for
> purposes of this subsection of an application filed in the United States only if the
> international application designated the United States and was published under Article
> 21(2) of such treaty in the English language.

8.   **Claims 1-3,** are rejected under 35 U.S.C. 102(e) as being anticipated by Bhagavatula et

al. U.S. Patent No. 7,140,036 (hereinafter '036).

    As to independent claim 1, "A method of authenticating a digitally encoded product

being originated by an entity having at least one authorized subject, the method including

the steps of: a client system transmitting a request of authentication of the product to a

server system" is taught in '036 col. 8, lines 20-25;

    "and returning a representation of the certification to the client system" is shown in

'036 col. 8, lines 54-67;

     "the server system verifying whether the request is received from an authorized

subject, and responsive to a positive verification: certifying that the product originates

from the entity using sensitive information of the entity stored on the server system" is

disclosed in '036 col. 7, line 57 through col. 8, line 25.

As to dependent claim 2, "wherein the step of verifying whether the request is received from an authorized subject includes: comparing an address of the client system with an indication of authorized addresses stored on the server system" is taught in '036 col. 5, lines 5-14.

As to dependent claim 3, "wherein the step of verifying whether the request is received from an authorized subject includes: comparing an identifier of a user logged on the client system with an indication of authorized users stored on the server system" is shown in '036 col. 8, lines 2-10.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   **Claims 4-8,** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhagavatula et al. U.S. Patent No. 7,140,036 (hereinafter '036) in view of Graves et al. U.S. Patent Application Publication No. 2004/0177047 (hereinafter '047).

As to dependent claim 4, the following is not taught in '036: **"wherein the step of certifying includes: automatically retrieving a private key of the entity stored on the server system, and digitally signing the product using the private key"** however '047 teaches that the PTA and private keys may be hosted in a number of locations such as a separate server, and

that the authentication process is carried out without human participation (i.e. automatically), and furthermore that the private key is used to create the digital signature on pages 5-6, paragraphs 0050 and 0052-0053.

It would have been obvious to one of ordinary skill in the art at the time of the invention of a centralized identity authentication for electronic communication network taught in '036 to include a means to utilize private keys for authentication. One of ordinary skill in the art would have been motivated to perform such a modification because there is a need for buyer authentication in online purchases see '047 (page 2, paragraph 011) "Thus, there is a need for substantial buyer authentication in online commerce transactions. There is further a need for an approach to buyer authentication which is also flexible enough to easily adapt to varying levels of security for different applications and also to the adoption of new technologies. The approach preferably also does not impose significant burdens on or require extensive modification of the existing transaction processing infrastructure".

As to dependent claim 5, "wherein the step of automatically retrieving the private key includes: calling a signing command passing a password for accessing the private key as a parameter" is taught in '047 page 6, paragraph 0053.

As to dependent claim 6, "wherein the step of automatically retrieving the private key includes: calling a signing command with an option causing the import of the private key from a private configuration memory area of the server system" is shown in '047 pages 5-6, paragraphs 0050 and 0052-0053.

As to dependent claim 7, "further including the steps of: the client system invoking a remote command on the server system, the server system verifying whether the remote

command is included in a predefined list stored on the server system, the list including at

least one remote command for satisfying the request of authentication, and the server

system executing the remote command if included in the list" is disclosed in '047 pages 5-6,

paragraphs 0050 and 0052-0053.

  As to independent claim 8, "A method of authenticating a software product being

originated by an entity having at least one authorized subject, the method including the

steps of: a client system transmitting a request of authentication of the product to a server

system" is taught in '036 col. 8, line 20-31;

  "the server system verifying whether the request is received from an authorized

subject, and responsive to a positive verification:" is disclosed in '036 col. 7, line 57 through

col. 8, line 25;

the following is not taught in '036:

  "generating a digital signature of the product using a private key of the entity stored

on the server system" however '047 teaches that the PTA and private keys may be hosted in a

number of locations such as a separate server, and that the authentication process is carried out

without human participation (i.e. automatically), and furthermore that the private key is used to

create the digital signature on pages 5-6, paragraphs 0050 and 0052-0053;

  "and returning the digital signature to the client system, wherein the digital

signature certifies that the product originates from the entity" however '47 teaches that a

digital record of the transaction can by shown with the digital signatures on page 6, paragraph

0056.

It would have been obvious to one of ordinary skill in the art at the time of the invention

of a centralized identity authentication for electronic communication network taught in '036 to

include a means to utilize private keys for authentication. One of ordinary skill in the art would

have been motivated to perform such a modification because there is a need for buyer

authentication in online purchases see '047 (page 2, paragraph 011) "Thus, there is a need for

substantial buyer authentication in online commerce transactions. There is further a need for an

approach to buyer authentication which is also flexible enough to easily adapt to varying levels

of security for different applications and also to the adoption of new technologies. The approach

preferably also does not impose significant burdens on or require extensive modification of the

existing transaction processing infrastructure".

Conclusion

11.   It is noted, PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN

"The use of patents as references is not limited to what the patentees describe as their own

inventions or to the problems with which they are concerned. They are part of the literature of

the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039

(Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA

1968)). A reference may be relied upon for all that it would have reasonably suggested to one

having ordinary skill the art, including nonpreferred embodiments (see MPEP 2123).

12.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ellen C Tran whose telephone number is

(571) 272-3842. The examiner can normally be reached from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the

organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/ELLEN TRAN/
Primary Examiner, Art Unit 2134
5 May 2008